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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/486,558	04/13/00	MAUBRU	M 05725.0555

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EXAMINER

LIOTT, C

ART UNIT	PAPER NUMBER
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1751

DATE MAILED:

12/22/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/486,558

Applicant(s)
Maubru et al.

Examiner
Caroline D. Liott

Group Art Unit
1751



☐ Responsive to communication(s) filed on _____.

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 20-47 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 20-47 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☒ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 5

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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Applicant's Preliminary Amendments filed 4/13/00 have been entered. Claims 1-19 have been canceled accordingly.

Claim Rejections

Claim 38 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 38 is indefinite with regard to the term "similar products." This term does not clearly define which organic solvents fall within the scope of the claimed invention. Deletion of this term from the claim is suggested.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

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Claims 20-24 and 26-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lowe.

Lowe, U.S. Patent No. 5,776,576, teaches hair dyeing compositions which contain a coupler and a 3,4,5-triaminopyrazole developer, which overlaps in scope with those of formula (IV) as claimed, see col. 1, line 64-col. 2, line 11. The developers and couplers may be present in the claimed amounts, see col. 2, lines 18-21 and 45-48. Lowe's preferred couplers include the claimed 4-amino-5-fluoro-2-hydroxytoluene, and 5-amino-2-methylphenol (which differs from the claimed coupler only in that it does not contain a fluoro group), see col. 2, lines 27-37. Lowe's compositions may comprise mediums as claimed at the claimed pH's, see col. 3, lines 21-32 and 49-52. The patentee teaches dyeing methods as claimed with oxidants as claimed, see col. 3, line 59-col. 4, line 11. Lowe exemplifies various compositions which contain a triaminopyrazole developer in combination with the coupler 5-amino-2-methyl phenol, which compositions are applied to hair in dyeing methods as claimed, see Examples 4-7. Lowe does not exemplify a composition which contains or method which uses a coupler as claimed. The patentee also does not specifically teach the claimed kits.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to formulate a composition for dyeing hair which contains a triaminopyrazole oxidation base and the coupler 4-amino-5-fluoro-2-hydroxytoluene, wherein each component is present in a medium as claimed in the claimed amounts at the claimed pH's, and which compositions are applied to hair in dyeing methods as claimed, because such compositions and methods fall within

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the scope of Lowe's teachings. Particularly, it would have been obvious to those skilled in the art to substitute the 2-methyl-5-aminophenol in Lowe's Examples 4-7 with 4-amino-5-fluoro-2-hydroxytoluene as claimed, resulting in dyeing compositions and processes as claimed, because the patentee teaches the equivalence between these couplers for use in the patentee's compositions. The Office holds the position that the containment of Lowe's compositions in kits as claimed would have been obvious to those skilled in the art because such kits are conventional for the storage of two-part (i.e. dye and oxidant) hair dyeing compositions.

Claims 20-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kalopissis in view of Clausen.

Kalopissis, U.S. Patent No. 3,918,896, teaches compositions for dyeing hair which contain at least one oxidation base in combination with at least one halogenated coupler of formula (I) as claimed, see Abstract. Kalopissis teaches that p-aminophenol oxidation bases may be used, particularly when mahogany or chestnut colors are desired, see col. 2, lines 44-50. Kalopissis teaches that the oxidation bases and couplers may be present in mediums as claimed in the claimed amounts at the claimed pH's, see col. 3, lines 22-24; 45-49 and 61-66. The compositions are applied to hair with oxidants as claimed in methods as claimed, see col. 3, line 67-col. 4, line 7. Kalopissis exemplifies various compositions which contain a coupler as claimed in combination with p-aminophenol, which compositions are applied to hair in dyeing methods resulting in chestnut, mahogany or red hair colors, see Examples 22, 27 and 32. Kalopissis does not teach pyrazole oxidation bases as claimed, and does not specifically teach the claimed kits.

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Clausen, U.S. Patent No. 5,061,289, teaches hair dyeing compositions which contain a developer and coupler, wherein the developer is a diaminopyrazole of formula (I), which diaminopyrazoles encompass those as claimed, and are used in the claimed amounts, see col. 1, line 63-col. 2, line 22. Clausen teaches that such diaminopyrazoles are used to dye hair brilliant red shades with a great depth of color when combined with conventional couplers, and that such developers are physiologically acceptable as compared to p-aminophenol which is conventionally used to obtain red shades, see col. 1, lines 38-65.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to at least partially substitute the p-aminophenol oxidation base of Kalopissis, such as in the patentee's Examples 22, 27 and 32, with a diaminopyrazole as claimed in the claimed amounts, resulting in dyeing compositions and methods as claimed, because Clausen teaches that the claimed diaminopyrazoles are an improvement over p-aminophenol because they have better physiological properties. Furthermore, Clausen teaches that the claimed diaminopyrazoles obtain brilliant red shades when combined with conventional couplers, further motivating those skilled in the art to replace Kalopissis's red oxidation base p-aminophenol with a diaminopyrazole oxidation base as claimed, absent a showing otherwise. The Office holds the position that the containment of the compositions of Kalopissis as modified by Clausen in kits as claimed would have been obvious to those skilled in the hair dyeing art because such kits are conventional for the storage of two-part oxidative hair dyeing compositions.

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Comparative Examples

Examiner notes the comparative Examples in the specification which show that three compositions which contain an oxidation and coupler as claimed result in dyeings with improved resistance to perspiration as compared to a composition which differs only in that it contains an equimolar amount of the coupler m-aminophenol. These results are not deemed persuasive to overcome the above rejections because they do not compare any composition representative of the closest prior art as relied upon above. Showings of unexpected results must compare the closest prior art. See *Ex parte Beck*, 9 USPQ 2d 2000 (BPAI 1987); *In re Burkel*, 201 USPQ 67 (CCPA 1979), and *In re Merchant*, 197 USPQ 785 (CCPA 1976).

Furthermore, a single oxidation base as claimed was compared, which is not representative of the scope of the claimed pyrazoles. Evidence of unobviousness must be commensurate in scope with the claims. See *In re Kulling*, 14 USPQ 2d 1056, 1058 (Fed. Cir. 1990).

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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Claims 20-47 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-23 of U.S. Patent No. 6,090,162. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the patent recite hair dyeing compositions which contain a diaminopyrazole oxidation base and halogenated m-aminophenol coupler, both of which overlap in scope with those as currently claimed, as well as the corresponding hair dyeing methods and kits. The patented claims, therefore, obviate the instantly claimed invention.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Applicant is reminded that if any evidence is to be presented in accordance with 37 CFR 1.131 or 1.132, such evidence should be presented before final rejection in order to be considered timely.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Caroline Liott whose telephone number is (703) 305-3703. The examiner can normally be reached on Mondays-Thursdays from 8:30am to 6:00pm, and on alternate Fridays.

If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Yogendra Gupta, can be reached at (703)308-4708. All before final official faxes should be sent to (703) 305-7718. All after final official faxes should be sent to (703) 305-3599. All non-official faxes should be sent to (703) 305-6078.

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Any inquiry of a general nature should be directed to the Group receptionist whose telephone number is (703) 308-0661.

C.D.L.
December 18, 2000


CAROLINE D. LIOTT
PRIMARY EXAMINER